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Attorney Docket No. 0670-221

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	Group Art Unit: 2653
Makoto SATO	)	Examiner: A. Psitos
Serial No. 09/462,075	)	CERTIFICATE OF MAILING
Filed: January 6, 2000	)	I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 10.14.03.
For: DEVICE FOR INPUTTING TITLE OF RECORDING MEDIUM	)	Arlene M Stamper

RESPONSE

RECEIVED
OCT 24 2003
Technology Center 2600

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed July 14, 2003, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on January 6, 2000. A further Information Disclosure Statement was filed on August 11, 2003. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the Information Disclosure Statement filed on August 11, 2003.

Claims 1-7 are pending in the present application, of which claims 1, 4 and 7 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action asserts that "Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15" (page 2, Paper No. 18). It is noted in any event that the present application is a U.S. national stage

application submitted under 35 U.S.C. § 371. As stated in MPEP § 1893.03(b), "[an] international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office ...." As stated in MPEP § 1893.03(c), "[a] national stage application which includes a priority claim under 35 U.S.C. 119(a) and 365(b) must refer to a priority application, the priority of which was also claimed in the international stage of the international application." As stated in MPEP § 1895.01.I.C, "[in] national stage applications, a photocopy of the foreign priority document is received from the International Bureau and placed in the national stage application file. This copy of the foreign priority document is sufficient to establish that applicant has filed a certified copy of the priority document." The Applicant respectfully submits that the present application properly claims the benefit of PCT/JP98/02202, filed May 20, 1998, which, in turn, properly claims the benefit of JP 9-196596, filed July 6, 1997. The Applicant also notes that a copy of the International Application, and an English translation of the International Application were properly filed in the U.S. Patent Office on January 6, 2000. Accordingly, the Applicant respectfully submits that the earliest effective filing date of the present application, without perfecting Applicant's priority claim, is at least as of the international filing date of May 20, 1998.

The Official Action rejects claims 1, 4 and 7 as anticipated by either U.S. Patent No. 6,222,807 to Min-Jae or U.S. Patent No. 6,188,662 to Maeda et al. The Applicant respectfully submits that Min-Jae and Maeda are not available as prior art under § 102. As noted above, the earliest effective filing date of the present application is at least May 20, 1998. Min-Jae has an earliest effective filing date of March 2, 1999, and Maeda has an earliest effective filing date of December 4, 1998. Therefore, Min-Jae and Maeda are not available as prior art against the present application. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) are in order and respectfully requested.

The Official Action rejects claims 1, 4 and 7 as obvious based on the combination of either U.S. Patent No. 5,889,747 to Hisamatsu et al. or U.S. Patent No. 5,041,921 to Scheffler with either Official Notice or Japanese Published Unexamined Patent Application No. HEI 9-344748 to Yokota et al. (cited in column 2 of Maeda).

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art references, either alone or in combination, do not teach or suggest all the features of the independent claims. It is noted that Yokota (JP '748) is not available as prior art against the present invention. Yokota was published July 2, 1999, which is after the earliest effective filing date of the present invention. Further, Yokota is not officially of record in the present application. Still further, since Maeda is not prior art, the disclosure of Yokota in column 2 of Maeda reference is not prior art.

Hisamatsu, Scheffler and Official Notice, either alone or in combination, do not teach or suggest all the features of the present invention. The Official Action concedes

that the prior art does not teach or suggest "a secondary ability of inputting title information" (page 3, Paper No. 18). It appears that the Official Action asserts, using official notice, that "those using either word perfect, or word, Files can be dubbed from sources, and by use of the 'save as' function renamed" (pages 3-4, Id.).

In accordance with MPEP § 2144.03, the Applicants respectfully traverse the above-referenced assertions and request that the Examiner cite references in support of his position. The Applicants respectfully submit that the features of the present invention are not conventional and would not have been known to one with ordinary skill in the art at the time of the invention.

Hisamatsu, Scheffler and Official Notice do not teach or suggest the features of independent claims 1, 4 and 7 of the present invention. Specifically, the prior art do not teach or suggest a title input device with a second key that selects a target unit of the recording medium to input a title, and a second system controller that reads the desired received text information instructed to be called by the third key from the received text information stored in the capturing region buffer and records the desired received text information in the recording medium as a title name of the target unit selected by the second key, in response to operations of the third key and the second key (claim 1); a title input device with a second key that selects a target unit of the recording medium to input a title name character, a title inputting region that stores a title name input by a user corresponding to the target unit, a second system controller that writes a title name character input by the user in the title inputting region corresponding to the target unit desired by the user, reading the desired text information stored in the capturing buffer region when the first system controller instructs to call the desired received text information, and writing the title name in the title inputting region corresponding to the target unit desired by the user, in response to an operation of the second key, and wherein the second system controller records the title name corresponding to the target unit and stored in the title inputting region in the recording medium at a predetermined timing (claim 4); or a title input method including manually selecting a target unit of the

recording medium in order to input the desired text information as a title, and recording the desired text information as the title of the target unit of the recording medium (claim 7). The Applicant respectfully submits that the above-referenced features of the independent claims of the present invention are not considered to be common knowledge or well-known in the art.

Since Hisamatsu, Scheffler and Official Notice do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Official Action rejects claims 1, 4 and 7 as obvious based on the combination of either U.S. Patent No. 5,479,266 to Young et al. or U.S. Patent No. 5,488,409 to Yuen et al. with either Official Notice or Yokota (JP '748). The Official Action rejects claims 2-5 as obvious based on either the combination of either Min-Jae or Maeda with either JP 3-233670 to Tanosaki or JP 9-146528 to Shigeki et al.; as obvious based on the combination of either Hisamatsu or Scheffler with either Official Notice or Yokota, and either Tanosaki or Shigeki; and as obvious based on the combination of either Young or Yuen with either Official Notice or Yokota, and either Tanosaki or Shigeki. It also appears that claim 6 is rejected by the same combination of references as applied to claims 2-5. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As noted above, Min-Jae, Maeda and Yokota are not available as prior art. Young, Yuen, Tanosaki and Shigeki do not cure the deficiencies in Hisamatsu, Scheffler and Official Notice. Young, Yuen, Hisamatsu, Scheffler, Tanosaki, Shigeki and Official Notice, either alone or in combination, do not teach or suggest the features of independent claims 1, 4 and 7 of the present invention (see above).

Since Young, Yuen, Hisamatsu, Scheffler, Tanosaki, Shigeki and Official Notice do not teach or suggest all the claim limitations, a *prima facie* case of obviousness

cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

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